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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,099	12/11/2000	Johannes Dapprich	22650-001 CIP	5343

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EXAMINER

FORMAN, BETTY J

ART UNIT PAPER NUMBER

1634

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/735,099

Applicant(s)

DAPPRICH ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1,3-19 and 21.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Continuation of 3.

Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112:First Paragraph, New Matter and the Objection to the Specification.

Continuation of 5.

Applicant's request for reconsideration has been considered but does not place the claims in condition for allowance for the reasons stated below.

Applicant argues that the method of Whitcombe differs from that instantly claimed because Whitcombe amplifies the target nucleic acid and detects the amplified target but does not isolate and detect the actual nucleic acid sequence of interest itself from the starting material. The argument has been considered but is not found persuasive because the open claim language "comprising" encompasses any amplification step of Whitcombe. Additionally, the argument is not found persuasive because the instant claims are not limited to detection of the "starting nucleic acid sequence" as argued. In contrast, the claims are drawn to a method for separating a nucleic acid sequence of interest. The claims are not limited to separation of the starting nucleic acid and the claims do not recite method steps for isolation and detection of the starting nucleic acid. Therefore, the argument is not relevant to the instant claims.

Applicant argues that the instant invention requires that the attachment of the separation group is conditional on the presence of a distinguishing element in the vicinity of the bound targeting element but Lundeborg does not describe the conditional attachment. The argument has been considered but is not found persuasive because as Applicant notes, the instantly claimed attachment is conditional on the presence of the distinguishing element. Lundeborg teaches the method wherein the separation group attachment is improved/enhanced in the presence of the distinguishing element (Column 1, lines 57-63 and Column 5, lines 18-65). As such, the attachment is conditional i.e. improved/enhanced in the presence of the distinguishing element. The claims are given the broadest reasonable interpretation consistent with the claim language whereby "conditional" is encompassed by the improved/enhanced attachment conditions of Lundeborg. The courts have stated that claims must be given their broadest reasonable interpretation consistent with the specification *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969); and *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (see MPEP 2111).

Regarding Claims 16 and 19, Applicant reiterates the arguments discussed above. The arguments have been considered but are not found persuasive for the reasons stated above.

